

Applicant : Neil H. Bander  
Serial No. : 09/929,665  
Filed : August 13, 2001  
Page : 11 of 13

Attorney's Docket No.: 10448-184009 / MPI1996-  
037P2RDV1ACNA1; CRF D-1912M

### REMARKS

Claims 144, 146, 148, 150, 152, 154, 156-168, 170-184, 186, 188, 190, 192, 194, and 196-199 are pending. Claims 144, 146, 148, 150, 152, 154, 156-168, 170-177, 184, 186, 188, 190, 192, 194, and 196-198 have been amended. Claims 145, 147, 149, 151, 153, 155, 185, 187, 189, 191, 193 and 195 have been cancelled. Support for the amendments to the claims can be found throughout the application as originally filed. No new matter has been added.

The specification has also been amended to obviate the Examiner's objections. No new matter was added.

#### *Claim Objections*

Claims 145, 147, 149, 151, 153 and 155 are "objected to under 37 CFR 1.75(c), as being of improper dependent form." These claims have been cancelled, thereby obviating this objection.

#### *Rejection of Claims 145 and 151 Under 35 U.S.C. §112, second paragraph*

Claims 145 and 151 are rejected under 35 U.S.C. §112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Claims 145 and 151 have been cancelled, thereby obviating this rejection.

#### *Rejection of Claims 144, 145, 147- 151, and 153-183 Under 35 U.S.C. §112, first paragraph*

Claims 145, 147, 149, 151, 153 and 155 are rejected under 35 U.S.C. §112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Claims 145, 147, 149, 151, 153 and 155 have been cancelled, thereby obviating this rejection.

Applicant : Neil H. Bander  
Serial No. : 09/929,665  
Filed : August 13, 2001  
Page : 12 of 13

Attorney's Docket No.: 10448-184009 / MPI1996-  
037P2RDV1ACNA1; CRF D-1912M

Claims 144-145, 148-151, and 154-183 are also rejected since "applicants do not state that all restrictions upon public access to the deposits will be irrevocably removed upon grant of a patent on this application and that the deposits will be replaced if the depository cannot dispense the vials."

Without conceding the issue, a Declaration of Availability is filed herewith and asserts that hybridoma HB-12126 was deposited with the ATCC under the conditions of the Budapest Treaty.

***Rejection of Claims 144-173, and 178-183 Under 35 U.S.C. §102(b)***

Claims 144-160, 172-173 and 178-183 have been rejected under 35 U.S.C. §102(b) "as being anticipated by EP 125023-A (Cabilly *et al.*, November 1984). Specifically, the Examiner asserts that "for the purposes of comparing the claims to the prior art, the claims are interpreted as comprising any antigen binding portion (of any length) that contains *any* one amino acid sequence of the aforementioned sequences."

Although Applicants respectfully disagree with the Examiner's interpretation of the claims, the claims have been amended to recite that the antibody or antigen binding portion thereof bind to prostate specific membrane antigen (PSMA). Cabilly *et al.* does not teach or suggest an antibody or antigen binding portion thereof that binds to PSMA. Thus, Cabilly *et al.* does not teach or suggest every element of the claims, and therefore, does not anticipate the claimed invention.

The Examiner also rejected claims 144-173 and 178-183 under 35 U.S.C. §102(b) "as being anticipated by WO 91/07493 (Better *et al.*, May 1991)."

As stated above, the claims, as amended, recite that the antibody or antigen-binding portion thereof binds to PSMA. Better *et al.* does not teach or suggest an antibody or antigen binding portion thereof that binds to PSMA. Thus, Better *et al.* does not teach or suggest every element of the claims, and therefore, does not anticipate the claimed invention.

For the reasons discussed above, Applicants respectfully request that the Examiner withdraw this rejection.

Applicant : Neil H. Bander  
Serial No. : 09/929,665  
Filed : August 13, 2001  
Page : 13 of 13

Attorney's Docket No.: 10448-184009 / MPI1996-  
037P2RDV1ACNA1; CRF D-1912M

***Obviousness Type Double Patenting Rejection***

Claims 144-158, 172-173 and 178-183 "are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22, of U.S. Patent No. 6,107,090.

A terminal disclaimer is being filed herewith, thereby obviating this rejection.

Please apply the fee for a one-month extension of time and any other charges or credits to deposit account 06-1050 (referencing 10448/184009).

Respectfully submitted,

Date: \_\_\_\_\_

*DRAFT*  
\_\_\_\_\_  
Laurie Butler Lawrence  
Reg. No. 46,593

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

20744864.doc